

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

Date:	23-Sep-08	APPL. S. N:	10578525
To Examiner:	FOGARTY, CAITLIN	Art Unit	1793
From	Thomas, Deborah PARALEGAL SPECIALIST	Return This Memo To: Case Drop-Off Location	REM8A30

SUBJECT: Decision on Terminal Disclaimer(T.D.) filed:

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete,

please initial, date and return this memo to me. THANK YOU.

- The T.D. is PROPER and has been recorded (see 14.23).
- The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see 14.24):
- The TD fee of [REDACTED] has not been submitted nor is there any authorization in the application file for the use of a deposit account.
 - The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see 14.26 & 14.26.01).
 - The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see 14.27.01).
 - The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490) (see 14.26 & 14.26.02).
 - The person who signed the T.D.:
 - is not an attorney "of record" (see 14.29 and 14.29.01).
 - has failed to state his/her capacity to sign for the business entity (see 14.28).
 - is not recognized as an officer of the assignee (see 14.29 & possible 14.29.02).
 - No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see 14.30).
 - The T.D. is not signed (see 14.26 & 14.26.03).
 - The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see 14.32).
 - The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see 14.26, 14.27.02 or 14.26.05).
 - The period disclaimed is incorrect or not specified (see 14.26, 14.27.02 or 14.26.03).
 - Other: [REDACTED] 
 - Suggestion to request refund (see 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex.Initials: _____ Date: _____

Log Date:

Application Number 	Application/Control No. 10/578,525	Applicant(s)/Patent under Reexamination KIZU ET AL.
Document Code - DISQ		Internal Document – DO NOT MAIL

TERMINAL DISCLAIMER	<input checked="" type="checkbox"/> APPROVED	<input type="checkbox"/> DISAPPROVED
Date Filed : August 4, 2008	This patent is subject to a Terminal Disclaimer	

Approved/Disapproved by:

Henry D. Jefferson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 1793	Customer No.: 035811
Examiner	: Caitlin Anne Fogarty	
Serial No.	: 10/578,525	
Filed	: May 8, 2006	
Inventors	: Taro Kizu : Kaneharu Okuda : Toshiaki Urabe : Hiromi Yoshida : Yoshihiro Hosoya	Docket No.: SUG-06-1107 Confirmation No.: 1361
Title	: HIGH-STIFFNESS HIGH-STRENGTH : THIN STEEL SHEET AND METHOD : FOR PRODUCING THE SAME	

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Your Petitioner, T. Daniel Christenbury, represents that he is patent counsel for JFE Steel Corporation, which is the owner of the entire interest in the above Application Serial No. 10/578,525, filed May 8, 2006 for HIGH-STIFFNESS HIGH-STRENGTH THIN STEEL SHEET AND METHOD FOR PRODUCING THE SAME, as evidenced by an Assignment recorded at Reel 019067, Frame 0296 of the U.S Patent and Trademark Office records, and is also the owner of U.S. Patent Application No. 10/578,524, filed May 8, 2006 for HIGH-STIFFNESS HIGH-STRENGTH THIN STEEL SHEET AND METHOD FOR PRODUCING THE SAME as evidenced by an Assignment recorded at Reel 019073, Frame 0358 of the U.S. Patent and Trademark Office records, convenience copies of which are attached. Your petitioner has reviewed the relevant documentary evidence and certifies to the best of his knowledge and belief, that title is in JFE Steel Corporation.

Your Petitioner, on behalf of the patent owner, hereby disclaims the terminal part of any patent to be issued on said application Serial No. 10/578,525 which would extend beyond the expiration date of a patent issuing from U.S. Patent Application No. 10/578,524 and hereby agrees that any patent so granted on the above-identified application shall be enforceable only during such period that the legal title to said application shall be the same as the legal title to a patent issuing from U.S. Patent Application No. 10/578,524, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

Your Petitioner does not disclaim any earlier than the expiration date presently shortened by this Terminal Disclaimer, even in the event that the patent issuing from said Patent No. 10/578,524 earlier expires for other reasons, such as failure to pay a maintenance fee, invalidity or unenforceability, or is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321(a), or has all claims canceled by a reexamination certificate, or is otherwise wholly or partially terminated prior to the expiration of its term. If any part of this paragraph should be held to render this Terminal Disclaimer ineffective, then that part shall be deemed to be of no effect.

Respectfully submitted,

JFE Steel Corporation

Date: 9/10/2008

By:


T. Daniel Christenbury, Patent Counsel